

Appl. No. 09/805,099
Atty. Docket No. 8244MLS
Amdt. dated 5/1/07
Reply to Office Action of 2/2/07
Customer No. 27752

REMARKS/ARGUMENTS

Claims 1-11, 15-18, 22, 24-53, 56-75, and 77-80 are now under consideration.

Claim 23 has been cancelled herewith, in view of the incorporation of its defining elements into Claim 1 (See §112 discussion, below). Claim 1 has been further amended to correspond the final “thereby” clause to the preamble language, which recites the purpose of the claimed method. It is submitted that these amendments are fully supported and entry is requested.

Specification

The specification has been amended to meet the Examiner’s objection (Office Action, page 4). Withdrawal of the objection is requested.

Rejections Under 35 USC 112

All claims stand rejected under §112 because of the “by prospective . . .” terminology (Office Action, pages 4-5). While it is clear that §112 does not require the claim language to be recited *in haec verba* in the specification, the claims have been amended to remove the assertedly unsupported terminology. Claim 1 now recites the individuals of original Claim 23. Withdrawal of all rejections on this basis is requested.

Rejections Under 35 USC 102/103

All claims stand rejected under §102(e) or, in the alternative, under §103(a) over US 6,491,840, for reasons of record at pages 6-13 of the Office Action.

Applicants again respectfully traverse all rejections under §102 and §103.

Controlling Case Law

The Examiner’s citation of *Ngai* and *Gulack* in support of the rejections is noted; i.e., “Where the only differences between a prior art product and a claimed product is printed matter . . .” [emphasis supplied] Of course, the present invention does not relate to a product, but rather to a method directed to the solution of a meaningful problem relating to the habits and practices of consumers.

What does *Ngai* say about method claims?

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In the LEXIS report at page 2, column 1, the Court in *Ngai* notes, "Thus, the Board argues, Ngai can claim the new use as a method, but cannot claim the existing product itself." [emphasis supplied] And, the *Ngai* Court liberally cited *Gulack*.

Net: The very case law cited by the Examiner clearly shows that a method claim would be proper under circumstances (printed instructions) that square with the method claims herein. As a matter of fairness, the Examiner is urged to reconsider any grounds for rejection that may be based on a misapprehension of *Ngai* or *Gulack*.

Rejections Under §102

As stressed in MPEP §2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (Citations omitted.) Moreover, "The identical invention must be shown in as complete detail as contained in the . . . claim." (*Ibid*; emphasis supplied)

Furthermore, not only must all the individual elements be found in a single document, but also they all must be arranged as in the claim under review. *In re Raymond G. Bond*, 910 F. 2d 831; 1990 US App. LEXIS 13087; 15 USPQ 2D (BNA) 1566 [cases cited at LEXIS document, page 2, II.]

Succinctly stated, US 6,491,840 does not meet the foregoing tests to support any rejection under §102, with regard to the claims as now amended. Nothing in '840 suggests any need to "target" any specific class/list of prospective users, much less suggests who such people might be. Accordingly, each and every element of the present claims is not found in '840, and the rejection should be withdrawn.

Rejections Under §103

The rejections under §103(a) over US 6,491,840 are traversed, because '840 is not available as prior art against the parent application under 35 USC §103(c).

Specifically, the present application and US 6,491,840 were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to, The Procter & Gamble Company. The Examiner's attention is directed to "(73) Assignee" on the title page of US 6,491,840 and to the recordation of the assignment of the present application at Reel 016663/Frame 0403.

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Moreover, as previously discussed, the present invention identifies and addresses a problem that was unrecognized in '840. This fact must be considered under the "invention as a whole" test of §103. The method herein addresses this previously unsuspected/unreported problem and, accordingly, is patentable under §103.

In light of the foregoing, withdrawal of the rejections under §103 is requested.

Respectfully submitted,

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